

REMARKS

Claims 1-6 were rejected as unpatentable over MESSER 5,991,740. Reconsideration and withdrawal of the rejection are respectfully requested because one of skill in the art would not make the modification suggested in the Official Action and because there is no evidence to support the rejection.

MESSER discloses a system that includes user terminals 10, a merchant's web site 40, a content provider 20, and a clearinghouse 30. A merchant places an advertisement 25 on a web site managed by the content provider. If a user links to the merchant's web site through the advertisement 25 on the content provider's web site and actually purchases the merchant's goods, the merchant pays the content provider a fee. The clearinghouse oversees this operation; it facilitates the arrangement between the merchant and the content provider, monitors purchases by the user, and provides the accounting to keep track of fees due to the content provider (column 4, line 46 though column 5, line 16).

The Official Action acknowledges that MESSER does not disclose that the advertiser's web server allows an access request from the user terminal only if the access request passes through the advertising web server. That is, MESSER does not disclose that the user cannot access the merchant's web site unless the request for access comes through the content provider.

Nevertheless, the Official Action states that this missing feature would be obvious to one of skill in the art because the content provider would be more than willing to enter a contract with the merchant that requires the user to access the merchant's site through the content provider's web site in view of the referrals fees generated.

However, it is not clear why one of skill in the art would modify MESSEER to do this. The MESSEER system provides a clearinghouse that tracks the purchases and provides fees to the content provider. The MESSEER system already provides the referral fees attributed in the Official Action as motivation to modify MESSEER. It does not appear that additional fees would be generated by the modification.

Accordingly, restricting access in the manner suggested in the Official Action would not enhance the MESSEER system and one of skill in the art would not make the modification suggested in the Official Action.

The Official Action also does not provide any evidence in support of the bald assertion that one of skill in the art would modify MESSEER. There must be some concrete evidence of record to support the modification offered in the Official Action. Without evidence, the Official Action merely offers an unsupported opinion. The factual question of motivation to modify MESSEER is material to patentability and is not resolved based on subjective belief and unknown authority.

While it is permissible to provide an explanation based on logic and sound scientific reasoning to support a holding of obviousness, the explanation offered in the Official Action amounts to an assertion that one of ordinary skill of the art would have been able to arrive at the applicant's invention because he had the necessary skills. It is well established that this is not an appropriate standard for obviousness.

In establishing a *prima facie* case of obviousness, it is incumbent on the Patent Office to provide a reason why one of ordinary skill in the art would have been led to modify MESSER to arrive at the claimed invention. To this end, the motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicant's disclosure. It appears that the only reason to modify MESSER (there is no other evidence of record) results from a review of the present application, and thus the §103 rejection of claims 1-6 should not be maintained.

New claim 7 defines an embodiment of the invention that is also patentable. MESSER does not disclose an advertising web server that provides a second web site that includes a link to the first web site where the advertising web server appends an identification code that is unique to the advertising web server to a user's request for access, via the link, to the first web site, and where the advertiser's web server evaluates a validity

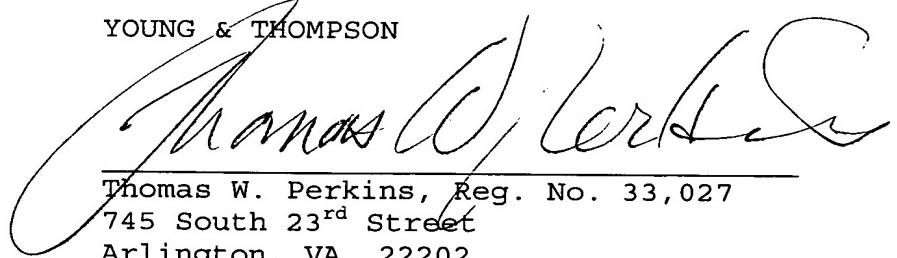
of the identification code and provides to the user, in response to the request and when the identification code is valid, an address for the first web site that is useable for only one time by the user. New claim 8 is allowable for similar reasons. Accordingly, consideration and allowance of claims 7-8 are respectfully requested.

In view of the present amendment and the foregoing remarks, it is believed that the present application has been placed in condition for allowance. Reconsideration and allowance are respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

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